

liquid combustible fuel" modifies, or is intended to modify,, the recitation "where the ratio of combustible fuel: additive ranges from about 99:1 to 0:100 by volume". Especially considering that claim 1 does not contain additional "combustible fuel". Claim 1 is rendered indefinite by the recitation that the composition excludes "aromatic organic compounds" and also excludes compounds of phenanthrene", i.e., phenanthrene is an aromatic organic compound. Claim 1 is rendered indefinite by the recitation on page 85, line 21 and 22 of "(e.g., alkyl or alkenyl)". Claim 1 is rendered indefinite by the recitation "other organic diacids are excluded", i.e., the claim fails to define which organic acids are excluded.

Claim 2 fails to positively recite the composition, i.e., it appears that claim 2 should be amended to recite "The additive composition of claim 1 comprising. . .".

Claim 2 lacks antecedent basis to recite "the refined combustible fuel". Additionally, it is unclear how the recitation "having a viscosity similar to that of the liquid combustible fuel" modifies, or is intended to modify, the recitation "where the ratio of combustible fuel: additive ranges from about 99:1 to 1:99 by volume". Especially considering that claim 2 does not contain additional "combustible fuel".

Claim 3 fails to positively recite the composition, i.e., it appears that claim 3 should be amended to recite "The additive composition of claim 1 comprising . . .".

In Claim 3, component "b", improperly recites "one or more alcohols selected from the group consisting of alcohols, iso-propanol and butanol". Additionally, it is unclear how the recitation "having a viscosity similar to that of the liquid combustible fuel" modifies, or is intended to modify, the recitation "where the ratio of combustible fuel: additive ranges from about 90:10 to 95:5 by volume". Especially considering that claim 3 does not contain additional "combustible fuel",

Claim 4 fails to positively recite the composition, i.e., it appears amended to recite "The additive composition of claim 1 comprising. . .".

Claim 4 is rendered indefinite by the recitation "alcohols having carbon atoms as defined herein" (emphasis added)."

Likewise the Examiner states that similar rejections under 35 U.S.C. § 112 2nd paragraph also apply to claims 5-28.

"Claim 29 fails to particularly point out and distinctly claim the "soluble alcohol" used in step "a", i.e., the claim fails to define what the alcohol must be soluble with or in (e.g., diesel fuel, fatty acid, water, etc.). The "(" in the 10th line of claim 29 appears to be misplaced. The proviso that begins in the 10th line of claim 29

is confusing and renders the claim indefinite.”

Applicant respectfully traverses this rejection.

Applicant have amended the claims extensively which Applicant believe overcomes this restriction.

Applicant has replaced all claims with the claims amended from the PCT Chapter II under Article 34 in the written opinion.

These claims are those now pending in the corresponding PCT application PCT/US99/00598.

The support for these amended and newly presented claims is found throughout the specification claims and figures as filed.

No new matter has been added to this application.

Therefore, Applicant argues that this rejection has been overcome.

Reconsideration and withdrawal is respectfully requested.

RESTRICTION PURSUANT TO 35 USC 121

“Examination of this application reveals that it appears to be drawn to numerous different, distinct, and independent inventions. Because the claims are cast in such form (as discussed above) and set forth so many possible additive products and compositions containing said products, it is impossible to list all of the different, distinct, and independent inventions present. Accordingly, at this time, restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-28, drawn to an additive composition or combustible fuel, classified in class 44' subclass 302.

II. Claim 29, drawn to a method of determining the suitability of a composition as a useful additive to a combustible fuel to improve combustion, classified in class 44, subclass 903.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions, i.e., claims 1-28 are directed to a composition comprising a combination of specific additives whereas claim 29 is directed to a method of determining the suitability of a composition as a useful additive to a combustible fuel and is not limited to the additive(s) of claims 1-28.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143)."

Applicant respectfully traverses this restriction.

However to advance the prosecution of this application, Applicant elects Group I to Claims 1-28, with traverse.

As a species of a combustible fuel, Applicant elects diesel fuel, with traverse.

Applicant reserves the right to revisit this issue when claims are allowed.

SUMMARY

Based on the above arguments and amendments, Applicant argue that these claims are now of a form and allow once.

A petition for extension of time and fee are enclosed.

If the Examiner has any questions, please call the undersigned at 650-324-1677 x 20 as soon as possible.

The Examiner is authorized to charge or credit PTO Deposit Account No. 16-1331 for any needed expense in the filing of this response.

Respectfully submitted,



Date: March 10, 2000

Howard M. Peters (Reg. No. 29,202)

Attorney of Record

PETERS, VERNY, JONES & BIKŠA, LLP

385 Sherman Avenue, Suite 6

Palo Alto, CA 94306-1840

Telephone no. (650) 324-1677

Facsimile no. (650) 324-1678

Attorney Docket No. 3596.02-1

HMP:ja

Enclosure - Petition for Extension of Time and Fee

f:\hmp\3596.02-1\amend2.wpd